Remarks/Arguments

Claims 18, 20, and 24 are pending in the above-captioned application.

The rejection under 35 USC § 103 should be withdrawn

Claims 18, 20 and 24 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 5,705,713 (Chambers) in view of U.S. Patent No. 5,264,570 (Johnson). Applicants respectfully submit that the invention as claimed in claims 18, 20, and 24 are unobvious in view of the combined teachings of Chambers and Johnson.

On page 4 of the Office Action dated February 15, 2008 ("Office Action") the Examiner states in regards to Applicant's argument that both Chambers and Johnson do not recognize the need for an improved method for separating by-products of the leaving group from the fluorinated product, that "there are no claim limitations which distinguish any type of different or improved separation step as that which is performed by Chambers, only that a separation step is performed." Applicants respectfully submit that there is a vast number of separation steps Chambers or Johnson could have used other than the separation method of the present invention. Second, unlike the present invention, neither Chambers nor Johnson teaches, discloses, or suggests using differential solubility to separate the by-products of the leaving group from the fluorinated product. It is important to note that "[a] basic mandate inherent in 35 U.S.C. §103 is that "a piecemeal reconstruction of prior art patents in light of the applicants' disclosure" shall not be the basis for a holding of obviousness." *In re Kamm and Young*, 452 F.2d 1052. (C.C.P.A. 1972).

Even assuming, *arguendo*, that the references are properly combinable; Applicants respectfully submit that any such combination would teach away from the present invention. 'Teaching away' simply means teaching a solution that would not lead to the claimed subject matter. As noted by the Federal Circuit:

> **A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.**
> ***Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085 (Fed. Cir. 1995).**

Unlike the present invention, Chambers clearly teaches toward a process for preparation of fluoro compounds wherein a compound of formula R^1R^2CHOX is converted to its fluorinated analog (col. 1, lines 65-clo. 2, line 5). The product may be "separated, e.g. by filtration, and purified in the usual way" (col. 4, lines 55-65). Example 1 describes a preparation of 2-fluoro-1,3,5-tri-O-benzoyl-α-D-ribofuranose wherein the product is precipitated from the reaction mixture without further purification. Johnson relates to a method for synthesizing 2-fluoro-2-deoxy-D-glucose by contacting 1,2,4,6-tetra-O-acetyl-2-O-trifluoromethanesulfonyl-2-deoxy-β-D-mannose with ^{18}F ion and deprotecting (col. 2, lines 55-67). Applicants respectfully submit that the mere fact that a reference such as Chambers, which generally suggest using a separation step, does not dictate that this 'separation' step will direct one to all other separation methods. The *Para-Ordnance* decision (above) clearly states that teaching away does not require a negative teaching in the prior art, the prior art need only teach other, divergent, solutions to be deemed to teach away from an invention. Thus, by teaching positively towards certain embodiments or features as being important or preferred, the art provides a motivation for the

person skilled in the art to go in a particular direction. If that direction leads towards subject matter outside the scope of the claims at issue, then it constitutes a "teaching away". Hence, unlike the present invention, Chambers and Johnson clearly teach away from any need for an improved method for separating by-products of a leaving group from a fluorinated product.

Also, on page 4 of the Office Action the Examiner states that "Chambers teaches the same leaving group as that which is claimed...". Applicants respectfully point out that in view of Chambers, one skilled in the art would not conclude using the leaving groups disclosed in the present invention. There are an infinite number of possible benzenesulfonate combinations that Chambers could have used other than the groups disclosed in the present invention. It is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). (emphasis added). Furthermore, the Examiner's selection from Chambers is an invalid hindsight selection based on identifying elements of the present claims in the prior art, without reference to what the prior art document teaches the person skilled in the art. Chambers has no real Examples of the various leaving groups disclosed in the present invention, so the person skilled in the art could not possibly have any motivation from Chambers itself to modify its claimed leaving group.

In view of the aforementioned, Applicants respectfully request that the Examiner reverse the rejection under 35 U.S.C. §103 (a) of claims 18, 20, and 24 and allow claims 18, 20, and 24.

CONCLUSION

In view of the foregoing, Applicants respectfully request that the Examiner reverse the rejection under 35 U.S.C. §103 (a) for claims 18, 20, and 24 as set forth in the Office Action and allow pending claims 18, 20, and 24 since they are in condition for allowance, and that the Examiner grant any other relief as it deems proper.

Respectfully submitted,

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